UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,495	09/12/2000	Arthur Koeppel	05793.3033	6314

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EXAMINER
GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	09/660,495	KOEPPEL ET AL.
Office Action Summary	Examiner	Art Unit
	Luke Gilligan	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *27 July 2004*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *14-18,20-23,26 and 40-84* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *14-18,20-23,26 and 40-84* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *10182004*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Response to Amendment

1.   In the amendment filed 7/27/04, the following has occurred: claims 1-13, 19, 24-25, and

27-39 have been canceled, claims 73-84 have been added and claims 14-15, 17, 20, 23, 26, 40,

48, 51, 62, and 70 have been amended. Now, claims 14-18, 20-23, 26, and 40-84 are

presented for examination.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 14-18, 20-23, 26, and 73-75 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mason et al., U.S. Patent No. 6,401,075 in view of Himmel et al., U.S. Patent

No, 6,317,782.

4.   As per claim 14, Mason teaches a system for performing dynamic Web-based

marketing, the system comprising: a Web server for providing a Web page over a network,

wherein the Web page includes content (see column 4, lines 5-9); a plurality of third party nodes

connected to the network (see Figure 1); a first plurality of users, each user located at a

respective client node, for requesting and viewing the content in the Web page provided by the

web server, wherein each client node is connected to the Web server through the network (see

column 4, lines 5-9); a first client side program, executed at each client node, for collecting user

response data associated with the content in the Web page provided to each client node, and

sending the collected user response data to a first server side data store via the Web server as

event data (see column 4, lines 20-25); an analytical program, executing in the Web server, for

analyzing the event data to determine user in view characteristic data, producing result data in response to the analysis of the event data, wherein the result data is based on at least the analysis of the user in-view characteristic data, and modifying the content of the Web page based on the result data (see column 6, lines 27-45). Mason does not explicitly teach that user in-view characteristic data reflects whether the content was viewable or partially viewable by the respective user. However, Himmel teaches a method for tracking advertising documents including collecting data regarding whether content was viewable or partially viewable by a user (see column 9, lines 60-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Mason. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of providing more accurate billing of advertisers based on actual viewing of advertisements (see column 3, lines 42-53 of Himmel).

5.   As per claim 15, Mason in view of Himmel teach the system of claim 14 as described above. Mason further teaches generating billing records based on the analysis of the event data (see column 5, lines 4-9); and sending the billing records to at least one of a plurality of third party nodes (see column 5, lines 9-32).

6.   As per claim 16, Mason in view of Himmel teach the system of claim 15 as described above. Mason further teaches the content includes a plurality of third party content, each third party content associated with a respective one of the plurality of third party nodes (see column 5, lines 20-31), and wherein the billing records include a plurality of third party billing records, each third party billing record associated with a respective third party content, and wherein sending the billing records includes sending each third party billing record to a respective third party node(see column 5, lines 4-9).

7.   As per claim 17, Mason in view of Himmel teach the system of claim 15 as described

above. Mason further teaches generating billing records further includes generating a content

effectiveness record associated with the content and appending the content effectiveness

record to at least one of the billing records, wherein the content effectiveness record includes

data reflecting the effectiveness of the content based on the analysis of the user initiated

responses (see column 4, lines 44-53).

8.   As per claim 18, Mason in view of Himmel teach the system of claim 17 as described

above. Mason further teaches the content effectiveness record includes information associated

with user in-view characteristics relating to the content (see column 4, liens 44-53).

9.   As per claim 20, Mason in view of Himmel teach the system of claim 14 as described

above. Mason does not explicitly teach user in-view characteristic data includes information

associated with at least one of user mouse position data, user screen scrolling position data and

time data associated with the mouse position and screen scrolling position data. Himmel further

teaches that user in-view characteristic data include information associated with at least one of

user mouse position data, user screen scrolling position data and time data associated with the

mouse position and screen scrolling position data (see column 9, lines 60-63). It would have

been obvious to one of ordinary skill in the art at the time of the invention to incorporate this

feature into the system of Mason for the reasons given above with respect to claim 14.

10.   As per claim 21, Mason in view of Himmel teach the system of claim 17 as described

above. Mason further teaches the content effectiveness record includes a report indicating a

plurality of user activities associated with the content and information indicating proposed

changes to the content based on the user activities (see column 4, lines 54-67).

11.   As per claim 22, Mason in view of Himmel teach the system of claim 21 as described

above. Mason further teaches the proposed changes include suggestions to modify selected

attributes of the content (see column 4, line 67 – column 5, line 3).

12.   As per claim 23, Mason in view of Himmel teach the system of claim 22 as described

above. Mason further teaches the selected attributes include attributes associated with at least

one of the listed attributes (see column 4, line 67 – column 5, line 3).

13.   As per claim 26, Mason in view of Himmel teach the system of claim 14 as described

above. Mason does not explicitly teach collecting non-activated in-view response data reflecting

whether the content was viewable or partially viewable to each respective user, wherein the

non-activated in-view response data is user response data that is not associated with a user

activating a button, icon or hyperlink on the Web page. Himmel teaches collecting non-

activated in-view response data reflecting whether the content was viewable or partially

viewable to each respective user, wherein the non-activated in-view response data is user

response data that is not associated with a user activating a button, icon or hyperlink on the

Web page (see column 9, lines 60-63). It would have been obvious to one of ordinary skill in

the art at the time of the invention to incorporate this feature into the system of Mason. One of

ordinary skill in the art would have been motivated to incorporate this feature for the purpose of

providing more accurate billing of advertisers based on actual viewing of advertisements (see

column 3, lines 42-53 of Himmel).

14.   As per claim 73, Mason in view of Himmel teach the system of claim 14 as described

above. Mason further teaches providing the modified content in response to receiving a

subsequent request from a client node to view the Web page (see column 6, lines 27-45).

15.   As per claim 74, Mason in view of Himmel teach the system of claim 14 as described

above. Mason further teaches a rule database including content rules for controlling the content

provided by the Web server (see column 6, lines 7-26); and wherein the analytical program

modifies the content according to the determined user in-view characteristics based on the

content rules (see column 6, lines 27-45).

16.   As per claim 75, Mason in view of Himmel teach the system of claim 14 as described

above. Mason further teaches the analytical program modifies at least one of the listed items of

content (see column 6, lines 27-45).

17.   Claims 40-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel et

al., U.S. Patent No, 6,317,782 in view of Mason et al., U.S. Patent No. 6,401,075.

18.   As per claim 40, Himmel teaches a method for performing dynamic Web-based in-view

monitoring, the method comprising the steps of: appending a client side routine to a Web page

provided by a Web server (see column 8, lines 13-22); sending the Web page to a plurality of

client nodes (see column 8, lines 22-28 and Figure 5); and displaying the Web page to a

plurality of users located at respective client nodes, and in response to the Web page being

displayed to each user, each client node initiating the client side routine to perform the steps of:

detecting in-view user activities associated with each respective user browsing the Web page,

wherein the in-view user activities are associated with in-view response data reflecting whether

or not the content data was viewable to each respective user (see column 8, lines 22-28);

collecting data reflecting the in-view user activities (see column 8, lines 40-53); detecting a client

side trigger event (see column 8, lines 54-59); and sending the collected data to the Web server

in response to the detected client side trigger event (see column 8, lines 59-65); and analyzing

the collected data to determine user in-view characteristic data reflecting whether the content

was viewable or partially viewable or partially viewable by the respective user (see column 9,

lines 60-63). Himmel does not explicitly teach modifying the content of the Web page based on

the user in-view characteristic data. Mason teaches modifying the content of the Web page

based on the user in-view characteristic data (see column 6, lines 27-45). It would have been

obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature

into the system of Himmel. One of ordinary skill in the art would have been motivated to

incorporate this feature for the purpose of enhancing the advertising capabilities of Himmel by

enableing modification at any time midstream during a specific ad placement (see column 2,

lines 14-17).

19.   As per claim 41, Himmel in view of Mason teach the method of claim 40 as described

above, wherein the in-view user activities includes at least one of mouse pointer movements,

screen scrolling, hyperlink selections, icon selections, data entry, time data associated with

mouse pointer position, time data associated with content position and time data associated

with screen scrolling (see column 9, lines 60-63).

20.   As per claim 42. Himmel in view of Mason teach the method of claim 40 as described

above, wherein the in-view user activities includes non-activated in-view response data

reflecting whether the content data was viewable or partially viewable to each respective user,

wherein the non-activated in-view response data is user response data that is not associated

with a user activating a button, icon or hyperlink on the Web page (see column 9, lines 60-63).

21.   As per claim 43, Himmel in view of Mason teach the method of claim 40 as described

above, wherein the client side routine is appended to a URL placed on the Web page (see

column 8, lines 20-22).

22.   As per claim 44, Himmel in view of Mason teach the method of claim 40 as described

above, wherein the collected data is stored in a client side data store and each client side trigger

event is associated with each respective client side data store being filled with the collected data

above a predetermined threshold level (see column 8, lines54-65).

23.   As per claim 45, Himmel in view of Mason teach the method of claim 40 as described above, wherein the client side trigger event is associated with a respective user closing a browser application executing at a respective client node (see column 10, lines 6-26).

24.   As per claim 46, Himmel in view of Mason teach the method of claim 40 as described above, wherein each client side trigger event is associated with a respective user, located at a respective client node, selecting a URL displayed on the Web page (see column 9, lines 28-41).

25.   As per claim 47, Himmel in view of Mason teach the method of claim 40 as described above, wherein the collected data reflecting the in-view user activities includes information indicating the proportion of content actually viewable to a respective user (see column 10, lines 11-14).

26.   As per claim 48, Himmel teaches the method of claim 40 as described above. Himmel does not explicitly teach analyzing the collected data at the Web server; generating billing records based on the analysis of the collected data; and sending the billing records to at least one of a plurality of third party nodes. Mason teaches analyzing the collected data at the Web server (see column 6, lines 27-30); generating billing records based on the analysis of the collected data (see column 5, lines 4-9); and sending the billing records to at least one of a plurality of third party nodes (see column 5, lines 9-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Himmel. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of enhancing the billing functions of Himmel (see column 3, lines 42-53 of Himmel).

27.   As per claim 49, Himmel in view of Mason teaches the method of claim 48 as described above. Himmel does not explicitly teach the content data includes a plurality of third party content data, and wherein each third party content data is provided by a respective one of the

plurality of third party nodes. Mason teaches the content data includes a plurality of third party content data, and wherein each third party content data is provided by a respective one of the plurality of third party nodes (see column 5, lines 20-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Mason for the reasons given above with respect to claim 48.

28.   As per claim 50, Himmel in view of Mason teach the method of claim 40 as described above, wherein the in-view user activities are mouse pointer position data (see column 9, line 60 – column 10, line 5).

29.   In addition, although Himmel does not explicitly teach the additional limitations recited in claims 76-78, Mason teaches these features as described above with respect to claims 73-75. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these content modification features into the system of Himmel for the reasons given above with respect to claim 40.

30.   Claims 51-61 and 79-81contain substantially similar system limitations to method claims 40-50 and 76-78 and, as such, are rejected for similar reasons as given above.

31.   Claims 62-72 and 82-84 contain substantially similar computer readable medium limitations to method claims 40-50 and 79-81 and, as such, are rejected for similar reasons as given above.

Response to Arguments

32.   In the remarks filed 7/27/04, Applicants argue in substance that (1) Mason does not teach a client-side program for collecting user response data associated with the content in the Web page and sending it to a Web server; (2) Mason does not teach determining user in-view characteristic data reflecting whether the content was viewable or partially viewable by the user;

(3) Himmel does not teach modifying the content of the Web page based on the user in-view characteristic data.

33.   In response to Applicants' argument (1), the Examiner respectfully submits that monitoring and recording the number of times a user accesses a derivative advertisement link is as form of collecting user response data associated with the content in the Web page. It is further submitted that this information is sent to a central processor or other computing device. Mason describes this process at column 4, lines 20-53. Therefore, it is respectfully submitted that this limitation as currently recited is taught by the system of Mason.

34.   In response to Applicants' arguments (2) and (3), it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In both the previous rejection and the current one, the Examiner has relied upon the teachings of Himmel for determining user in-view characteristic data reflecting whether the content was viewable or partially viewable by the user and upon the teachings of Mason for teach modifying the content of the Web page based on the user in-view characteristic data. Furthermore, these references have been combined to form these rejections. Therefore, it is respectfully submitted that these arguments are not persuasive in view of the grounds of rejection detailed above.

Conclusion

35.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

36.   A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
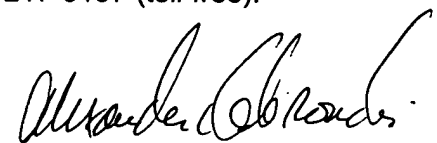
MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date

of this final action.

37.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner

can normally be reached on Monday-Friday 8am-5:30pm.

38.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

39.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLG
10/18/04

ALEXANDER KALINOWSKI
PRIMARY EXAMINER